

### **REMARKS**

This paper is filed in response to the Office Action mailed June 14, 2006.

Claims 1-19 are pending in this application. Claim 8 is rejected under 35 U.S.C. § 112, second paragraph, for lack of antecedent basis. Claims 1, 4, 7, and 12-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,128,006 to Rosenberg et al (hereinafter referred to as "Rosenberg '006"). Claims 2, 3, and 8-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of U.S. Patent Publication 2002/0033795 to Shahoian (hereinafter referred to as "Shahoian"). Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg '006 in view of U.S. Patent No. 6,211,861 to Rosenberg et al (hereinafter referred to as "Rosenberg '861"). The drawings were objected to as containing labeled elements that were not referred to in the specification.

Applicant has amended claim 8. No new matter is added by this amendment, and support may be found in the specification and claims as originally filed.

Applicant respectfully traverses the rejections of the claims and objections to the drawings. Reconsideration and allowance are respectfully requested in light of the amendments above and the remarks below.

#### **Objection to the Drawings**

Applicant respectfully traverses the objection to the drawings. The Office Action states that elements 506a and 506b of Figure 5 were not referenced in the specification. Applicant has amended a typographical error in paragraph 46, which previously erroneously referred to elements 606a and 606b. The paragraph now correctly refers to elements 506a and 506b. Applicant respectfully requests the Examiner withdraw the objection to the drawings.

#### **Claim 8 – § 112, second paragraph**

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. § 112, second paragraph, for having no antecedent basis for "the motor." Applicant has amended claim 8 to depend from claim 7, which recites "a motor." In view of this amendment, Applicant asserts that

“the motor” now has proper antecedent basis. Applicant respectfully requests the Examiner withdraw the rejection of claim 8.

Claims 1, 4, 7, and 12-19 – § 102(b) – Rosenberg ‘006

Applicant respectfully traverses the rejection of claims 1, 4, 7, and 12-19 under 35 U.S.C. § 102(b) as being anticipated by Rosenberg ‘006.

To anticipate a claim under 35 U.S.C. § 102(b), a reference must disclose each and every element of the claim. *See* M.P.E.P. § 2131.

Because Rosenberg ‘006 does not disclose “a touch-sensitive input device configured to move in a rotary degree of freedom” as recited in claim 1, Rosenberg ‘006 does not anticipate claim 1. Rosenberg ‘006 relates to rotary knobs or buttons, but those knobs and buttons are not disclosed to be touch-sensitive. One of ordinary skill in the art would not recognize the knobs and buttons of Rosenberg ‘006 to be touch-sensitive by virtue of their requiring user contact to manipulate. Rather, one of ordinary skill would recognize ‘a touch-sensitive input device’ to be responsive to the location and nature of a user’s touch, not the rotary movement of the input device by virtue of the user manipulating the input device. For example, the specification, in paragraph 11, recites

“[t]he personal MP3 player includes a touch-sensitive input device, touchpad 102. Touchpad 102 senses the position of a conductor, such as a finger, on the surface of the touchpad. The touchpad is further able to provide a position, comprising X and Y parameters, as well as a pressure, Z parameter, as an output signal. The touchpad 102 shown in Figure 1 utilizes capacitance, however, an embodiment of the present invention may be implemented in conjunction with any touch-sensitive input device, including resistive and membrane-switch touch-sensitive input devices.”

Further, the Microsoft Computer Dictionary, Fifth Edition, Copyright 2002, notes that a touch-sensitive display (or touch screen) is a computer screen designed or modified to recognize the location of a touch on its surface. p.524. Thus, a touch-sensitive input device is an input device that is responsive to a user’s touch. The wheels disclosed in Rosenberg ‘006 require movement of the wheel in order for the device to respond. In other words, the input to a touch-sensitive device is a touch, whereas the input to the wheel of Rosenberg ‘006 is movement of the

input device. Thus Rosenberg '006 does not disclose "a touch-sensitive input device configured to move in a rotary degree of freedom." Claim 1 is therefore patentable over Rosenberg '006.

As the Office Action notes, claims 14 and 17 relate to a method and computer readable medium containing computer code corresponding to the device of claim 1. Thus, claims 14 and 17 are patentable for at least the same reason as claim 1. Applicant respectfully requests the Examiner withdraw the rejection of claims 1, 14, and 17.

Because claims 4, 7, 12, 13, 15, 16, 18, and 19 depend from and further limit one of claims 1, 14, and 17, claims 4, 7, 12, 13, 15, 16, 18, and 19 are patentable over Rosenberg '006 for at least the same reason. Applicant respectfully requests the Examiner withdraw the rejection of claims 4, 7, 12, 13, 15, 16, 18, and 19.

Claims 2, 3, and 8-11 – § 103(a) – Rosenberg '006 in view of Shahoian

Applicant respectfully traverses the rejection of claims 2, 3, and 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg '006 in view of Shahoian.

To sustain a rejection of a claim under 35 U.S.C. 103(a), there must be a motivation to combine the references. See M.P.E.P. § 2143.01.

Because one of ordinary skill in the art would not be motivated to modify Rosenberg '006 to incorporate the device of Shahoian, claim 1, from which claims 2, 3, and 8-11 depend, claims 2,3, and 8-11 are patentable over the combination of Rosenberg in view of Shahoian. As discussed above, Rosenberg '006 teaches a rotary input device, wherein the user rotates the device to provide an input signal. As discussed above, the Rosenberg '006 is not a touch-sensitive device. Shahoian discloses a touch-sensitive device. A user generally interacts with the Shahoian device by touching or sliding a finger across the device. The device itself is not configured to be moved by the user, as the movement of the finger across the touch-sensitive surface provides the input signal, rather than the motion of the device. One of ordinary skill in the art would not be motivated to modify the Rosenberg '006 wheel to use a touch-sensitive surface because it would fundamentally alter the mode of operation of the Rosenberg '006 device.

As stated, the Rosenberg '006 wheel receives input based on the movement of the wheel, not the movement of a finger across the wheel. Were the Rosenberg '006 device to be made

touch-sensitive, the method of inputting data would be fundamentally changed – finger movement across the touch-sensitive surface would be difficult or impossible to control if the device were still configured to provide signals based on rotary movement. To allow for touch-sensitive input, the Rosenberg ‘006 device would need to be held stationary, so the user’s finger movement measurements would not be altered by inadvertent movement of the wheel. Fixing the Rosenberg ‘006 wheel in place would fundamentally alter the mode of operation of the wheel, and thus, one of ordinary skill in the art would not be motivated to modify the Rosenberg ‘006 device to be touch-sensitive. Therefore, claims 2, 3, and 8-11 are patentable over the combination of Rosenberg in view of Shahoian.

Claims 5 and 6 – § 103(a) – Rosenberg ‘006 in view of Rosenberg ‘861

Applicant respectfully traverses the rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg ‘006 in view of Rosenberg ‘861.

To reject a claim under 35 U.S.C. § 103(a), the combined references must teach or suggest each and every element of the claimed invention. See M.P.E.P. § 2143.03

Because Rosenberg ‘006 in view of Rosenberg ‘861 does not teach or suggest “a touch-sensitive input device configured to move in a rotary degree of freedom” as recited in claim 1, from which claims 5 and 6 depend, claims 5 and 6 are patentable over the combined references. As discussed above with respect to claim 1, Rosenberg ‘006 does not teach “a touch-sensitive input device configured to move in a rotary degree of freedom.” Rosenberg ‘861 does not cure this deficiency. Rosenberg ‘861 relates to providing haptic feedback to a mouse. Rosenberg ‘861 does not teach or suggest a touch-sensitive input device. Thus, the combination of Rosenberg ‘006 and Rosenberg ‘861 does not teach or suggest “a touch-sensitive input device configured to move in a rotary degree of freedom.” Thus, claims 5 and 6 are patentable over the combined references. Applicant respectfully requests the Examiner withdraw the rejection of claims 5 and 6.

Prior Art Made of Record and Not Relied Upon

In the Conclusion, the Office Action lists references which were made of record and not relied upon. Applicant respectfully traverses the characterization and relevance of these

references as prior art or otherwise, and respectfully reserves the right to present such arguments and other material should the Examiner maintain rejection of Applicant's claims, based upon the references made of record and not relied upon or otherwise.

**CONCLUSION**

Applicant respectfully asserts that in view of the amendments and remarks above, all pending claims are allowable and Applicant respectfully requests the allowance of all claims.

Should the Examiner have any comments, questions, or suggestions of a nature necessary to expedite the prosecution of the application, or to place the case in condition for allowance, the Examiner is courteously requested to telephone the undersigned at the number listed below.

Date:

9/14/2006

Respectfully submitted,



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